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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,938	04/10/2001	Tomoko Terakado	205602US6DIV	8040

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EXAMINER

SAJOUS, WESNER

ART UNIT	PAPER NUMBER
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2676

DATE MAILED: 12/08/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

# Office Action Summary

Application No.

09/828,938

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

Art Unit

2676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,20-27,31,33-48,52-61,65-76 and 81-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,20-27,31, 33-48,52-61,65-76 and 81-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Remarks**

This communication is responsive to the "After Final" response filed on November 06, 2003. Claims 1-2, 4-13, 20-27, 31, 47-48, 52-61, 66-76, and 81-88 are currently pending in this application. Claims 33-46 and 65 are canceled.

### **Response to Arguments**

1. The applicants' arguments with respect to the claims and prior art rejections have been considered but are moot in view of the new ground of rejections.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-13, 20-23, 25-26, 31, 47, 52, 54-61, 67, 69, 70-74, 75-77, 80-81, and 83-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US Pat. 5,410,326) in view of Niimi et al, US Pat. No. 5996028.

Considering claim 1, Goldstein, at figs. 1-1A, discloses a control device (5) which controls, by transmitting a control signal (see col. 7, lines 53-55), an electric apparatus

(8, *fig. 1*) that receives information transmitted via a transmission medium (e.g., *IR 29, see fig. 1A*) comprising a transmitting unit (29) for transmitting the control signal to the electric apparatus; a receiver (27) for receiving additional information (e.g., *favorite channels, see col. 6, lines 52-55 or advertising, see abstract*) that has been extracted from the received information and transmitted by the electric apparatus (e.g., the cable TV set); an output means (29) for outputting the additional information received by the receiver to a display device (10); a memory (e.g., *item 488 or 490 of fig. 20, see col. 26, lines 36-39*) for storing at least a portion of said additional information (e.g., *information favored by the user, see col. Col. 6, lines 52-55*).

It is noted that Darbee fails to teach a detachable IC card memory, and erasing unit for deleting the information stored in the memory based on a user controlled input.

However, Niimi teaches a detachable IC card memory (see *fig. 3, item 20, and col. 2, lines 45-54*), and erasing unit (*fig. 3, item 8*) for deleting the information stored in the memory based on a user controlled input (see *col. 4, lines 42-63, and col. 8, lines 15-64*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the detachable memory and deleting unit as taught by Niimi; in order to allow the user to check the contents of registered data in the memory without requiring a cumbersome operation. See Niimi's *col. 1, lines 54-55*.

ws Re claim 2, Goldstein ~~{inherently}~~ discloses additional information is an EPG that is included in the information received by the electric apparatus. See *col. 4, lines 28-30*,

wherein the date and time and channel associated with a future broadcast correspond with EPG information.

Re claim 4, the claimed "selecting unit for selecting ... information received by the receiver, wherein said memory is configured to store the information selected by the selecting unit" is met by the functions performed by item 142 of fig. 14 or figs 2A-D, and col. 10, lines 11-25 of Goldstein.

As per claim 5, (a) the claimed "second storing unit for storing the additional information..." is met by Goldstein's fig. 14, items 143-144.

In claim 6, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 in Goldstein.

The invention of claim 7 substantially recites the underlying elements of claim 1. As the various elements of claim 1 have been shown to render obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 7 are rejected for the same rationale set forth for claim 1.

The invention of claim 8 substantially recites the underlying elements as performed by method claim 7. As the various elements of claim 7 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 8 are rejected by the same rationale set forth for claim 7, for in the Goldstein's disclosure, a computer program or software incorporated in devices 28 and 36 is implemented for performing the invention.

The invention of claim 9 recites features substantially the same as claim 8; it is, therefore similarly rejected.

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Regarding claim 10, Goldstein discloses an electric apparatus (*e.g., a consumer electronic device or a TV set, see abstract*) which receives information that is transmitted via a transmission medium (*e.g., an antenna or a satellite*) and performs an operation in accordance with a control signal that is transmitted from a control device (10). It is noted that the television set in Goldstein is provided with a bi-directional communication capability with the remote control (see abstract and col. 4, lines 11-30). Thus, all the elements recited in claim 10, including the first receiving unit (27) for receiving the control signal transmitted from a control device (5); a controller (*e.g., a well known microcontroller or CPU*) for performing a control in accordance with the control signal (*e.g., and infrared signal from the remote controller*) received by the first receiving (*e.g., an IR receiver integral in the television set 9*); a second receiving unit (*e.g., a well known television tuner or*) for receiving the information transmitted via the transmission medium; an extracting unit (*e.g., a well known microcontroller or CPU*) for extracting additional information from the information received by the second receiving means; a transmitting unit (*e.g., a well know RF transmitter integral with the TV set*) for transmitting the additional extracted by the extracting means to the control device; wherein the control device (5) is configured to store (via items 140-141 of fig. 14) said extracting additional information (*e.g., advertisement or program guide information, see col. 4, lines 11-30*), although they are not shown in detail by Goldstein, they are noted to be well known components included in a conventional television set (9). These components could facilitate the applied set-top box or cable box (7) in Goldstein to communicate information to and from the remote controller 5. See cols. 7-8 in Goldstein.

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It is noted that Goldstein fails to teach a detachable IC card memory, and erasing unit for deleting the information stored in the memory based on a user controlled input.

However, Niimi teaches a detachable IC card memory (see fig. 3, item 20, and col. 2, lines 45-54), and erasing unit (fig. 3, item 8) for deleting the information stored in the memory based on a user controlled input (see col. 4, lines 42-63, and col. 8, lines 15-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (5) of Goldstein to include the detachable memory and deleting unit as taught by Niimi; in order to allow the user to check the contents of registered data in the memory without requiring a cumbersome operation. See Niimi's col. 1, lines 54-55.

The invention of claim 11 recites features equivalent to and performing the same functions as apparatus claim 10 and is similarly rejected.

The invention of claim 12 substantially recites the underlying elements as performed by method claim 11. As the various elements of claim 11 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the same rationale set forth for claim 11, for in the Goldstein, a computer program or software incorporated in items 89-91 of fig. 10 are implemented for performing the invention.

The invention of claim 13, including the limitations of: storing the computer program (e.g., via items 90-91) transmitted from the transmission medium (88); and controlling the electric apparatus (9 by using the computer program (incorporate in

items 89-91), substantially recites the underlying elements as performed by method claim 12. As the various elements of claim 12 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 12 are rejected under the same rationale set forth for claim 12, for in the Goldstein's disclosure, a computer program or software could be incorporated in devices 89-91 and/or in the well known microcontroller and ROM integral in the television set for performing the invention.

In claim 20, the claimed "control device instructs the electric apparatus to transmit the additional information" is by the function of item 89 of fig. 10 in Goldstein.

In claim 21, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 of by means of display 9 or 10 in Goldstein.

In claim 22, the claimed "electric apparatus is a personal computer" is obviously met by the depiction at col. 8, lines 42-44. The Applicant should duly note that since the system can transmit information via a modem to a data base connected to a local area network, a computer must be include as part of the local area network.

Re claim 23, the claimed "electric apparatus is a television receiver" is met by fig. 1, items 8-9 in Goldstein.

As per claims 25-26, the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric apparatus and which relates to information that will be received by the electric apparatus from a present time onward" would have obvious the system of Goldstein, since it enables the user to view program information, identifying PPV information (see



figs. 2-8) select information pertaining to specific genres or categories (see fig. 20) and to retrieve the selected category transmitted from the television set. The information when requested, are outputted in display 10 of the remote control. See col. 3, line 1 through col. 5, line 42.

Re claim 31, Darbee discloses the equivalence for the electric apparatus is a personal computer that accesses a server based on information transmitted from the remote control. See col. 8, lines 42-44. The applicant should duly note that since the system can transmit information via a modem to a database connected to a local area network based on instruction from the remote controller 10, it is apparent that the downloaded information can be accessed via a server.

Claim 47 recites features equivalent to and performing the same function as claim 7, it is, therefore, similarly rejected.

Claim 48 is rejected for the same reason as claim 2.

As per claim 52, the claimed "second storing unit for storing the additional information..." is met by Goldstein's fig. 14, items 143-144.

The limitation of claim 53 is met by the functions depicted at fig. 13 of Goldstein.

Claims 54, 69, and 83 recite features similar to claim 31; they are, therefore, rejected under the same rationale.

In claim 55, the claimed "notifying unit for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" is met by the depiction at col. 10, lines 5-40 in Goldstein.

In claim 56, Goldstein discloses a control device (5) that instructs the electric apparatus (via MPU 89) to transmit the additional information (e.g., advertisement, see abstract).

Re claims 57-59, the claimed "notifying means for notifying a user of reception of the additional information when the receiving means receives automatically receives the additional information" and the claimed "output means outputs that part of the additional information which relates to a channel of current reception of the electric apparatus" are equivalently met by the function of display 10 of figs. 2-9 in Goldstein.

The invention of claim 60 recites features equivalent to and performing the same functions as claim 47, and is, therefore, subject to rejections for the same reasons and rationale set forth for claim 47.

Claim 61 is rejected for reasons similar to claim 48.

Claims 67, 70-74 recite features similar to and performing the same functions as in claims 52, 55-59 respectively, and they are similarly rejected.

The invention of claim 75 substantially recites the underlying elements as performed by claim 1. As the various elements of claim 1 have been rendered obvious over the combined teachings of Goldstein and Niimi, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such the limitations recited in claim 75 are rejected for the same rationale set forth for claim 1.

Claims 76-77 are rejected for the same reasons as claims 2 and 3 respectively.

In claim 80, the claimed additional information ... advertisement information is stored in a prescribed area at said storing step" would have been obvious over the functionality of the remote controller 5 of Goldstein, for device 5 includes memory 90-91 coupled to controller 89, that upon receiving an instruction from the user may used to store such an additional information as desired by the user.

Claims 81, 84-88, respectively, are rejected for the same reasons as claims 5, 6, and 20-21, and 25-26, respectively.

4. Claims 24, 27, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Niimi and further in view of Hirose.

Considering claims 24, and 27, Darbee, and Niimi render obvious most claimed features of the invention but they fail to suggest that the second electronic apparatus is a recording apparatus performing recording reservation or a computer accesses a server based on the information transmitted from the control device.

Nonetheless, Hirose at fig. 1 illustrates a recording medium 7 as one of a plurality of electronic devices receiving information transmitted from a broadcasting station. Such recording medium is shown interfacing with a receiver. Such receiver is noted to be capable of receiving cable television broadcasting which could be used with a remote controller for transmitting signal to the receiver. Hirose also shows that a personal computer may be used to receive the information via a local area network. It is to be appreciated that computer, by means of the LAN, is able to access a server as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings suggested by Darbee and Takahashi and to incorporate their features with Hirose, in order to enhance the flexibility of the system.

Claim 53 recites features similar to claims 24 and 27 it is, therefore, similarly rejected.

### ***Conclusion***

**Any response to this action should be mailed to:**

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Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Wesner Sajous whose telephone number is (703) 308-  
5857. The examiner can also be reached on Mondays thru Thursdays and on alternate  
Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number  
for this group is (703) 308-6606.

**Wesner Sajous -WS-**



**12/2/2003**